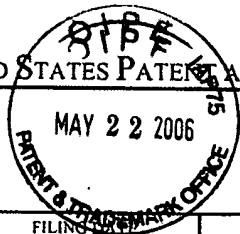




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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,820	09/26/2003	Michael C. Jones	DEP5086	6924

27777 7590 02/22/2006

PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

SWIGER III, JAMES L

ART UNIT PAPER NUMBER

3733

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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FEB 27 2006

J&J PAT. DKT. SECTION



# Office Action Summary

Application No.

10/671,820

Applicant(s)

JONES, MICHAEL C.

Examiner

James L. Swiger

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-13 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/9/05; 9/26/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because they are informally prepared and some items are unclear (for example, see Fig. 8). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

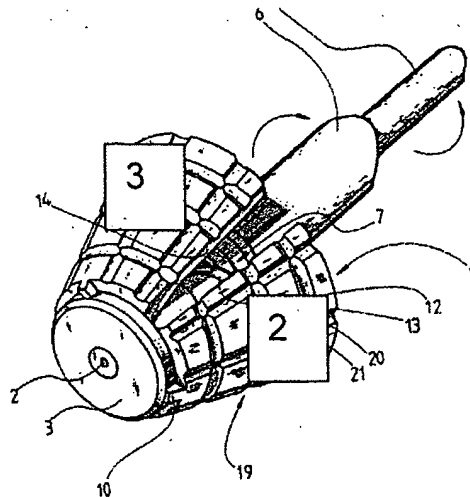
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8-13, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Parhofer et al. (Foreign Patent DE3630069). Parhofer et al. discloses a device having a first component defining a longitudinal axis (see Fig. 3, item 1), and a second component (19) movably associated with the first component (see joint at 10) in a radial direction (Fig. 2). The device further has a body (Fig. 3), and a stem extending from said body (6), and wherein the second component is tapered (Fig. 1). The device also has a restraining portion (8) and a cooperating portion of the second component (10) to provide restrained motion. The device also has a third component moveably

associated with the first component (See Fig. 2 below, and the section denoted as "3" is the third component).

Fig.2



Further, the internal side of component 2 has a surface associated with the first component (on the inside) while the second component has a surface capable of contact with bone material and that is also capable of urging the particles radially (see Col. 2 through Col. 3). The device also provides for a motion of the second component away from the longitudinal axis of the first component as the first component is advanced axially (Col. 5, lines 41-63).

With regards to claim 19, the device as claimed is inherently capable of performing the method that is comprised of a device with a first and second component and having a second component that may move in a radial direction. To use the device as it was intended an incision of some kind is required. Likewise, the instrument would not fit into the bone cavity without proper preparation.

***Allowable Subject Matter***

Claims 6-7 and 14-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLS

 2/21/2006

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER



Page 1 of 1

<b>Application Number</b>	10/671,820
<b>Confirmation Number</b>	6924
<b>Filing Date</b>	09/26/2003
<b>First Named Inventor</b>	Michael Jones
<b>Group Art Unit</b>	3733
<b>Examiner Name</b>	James L. Swiger, III
<b>Attorney Docket Number</b>	DEP5086

## U.S. PATENT DOCUMENTS

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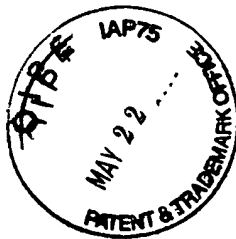
## FOREIGN PATENT DOCUMENTS

[illegible]

**OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS**

[illegible]

Examiner Signature	<i>James L. Surr</i>	Date Considered	<i>2/18/2006</i>
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PTO/SB08A (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

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**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Sheet 1 of 2

Application Number	
Filing Date	
First Named Inventor	Michael C. Jones
Group Art Unit	
Examiner Name	
Attorney Docket Number	DEP5085

**U.S. PATENT DOCUMENTS**

Examiner Initials	Cite No.	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document mm-dd-yyyy	Pages, Columns, Lines, where relevant passages or relevant figures appear
		Number	Kind Code <sup>2</sup> (if known)			
		2002/0058949		Iaia	05-16-2002	
		5,047,035		Mikhail, et al.	09-10-1991	
		5,089,004		Avenill et al.	02-18-1992	
		5,108,405		Mikhail, et al.	04-28-1992	
		5,129,283		Koehler	07-14-1992	
		5,147,408		Noble et al.	09-15-1992	
		5,180,388		DiCarlo	01-19-1993	
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		5,234,433		Bert et al.	08-10-1993	
		5,312,412		Whipple	05-17-1994	
		5,324,293		Rehmann	06-28-1994	
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		5,658,293		Vanlaningham	08-19-1997	
		5,718,707		Mikhail	02-17-1998	
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		5,766,178		Michielli et al	06-16-1998	
		5,788,704		Timperley	08-04-1998	
		5,897,560		Johnson	04-27-1999	
		5,928,240		Johnson	07-27-1999	
		5,935,169		Chan	08-10-1999	
		6,013,080		Khalil	01-11-2000	
		6,015,408		Pichon, et al.	01-18-2000	
		6,139,583		Johnson	10-31-2000	
		6,142,998		Smith et al.	11-07-2000	
		6,143,030		Schroder	11-07-2000	
		6,228,092		Mikhail	05-08-2001	
		6,248,110		Reiley, et al.	06-19-2001	
		6,270,502		Stulberg	08-07-2001	

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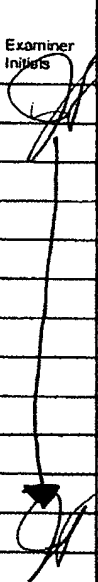
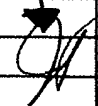
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STATEMENT BY APPLICANT**

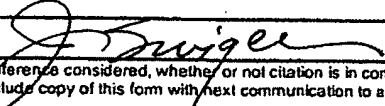
(use as many sheets as necessary)

Sheet 2 of 2

Application Number	
Filing Date	
First Named Inventor	Michael C. Jones
Group Art Unit	
Examiner Name	
Attorney Docket Number	DEP5085

**FOREIGN PATENT DOCUMENTS**

Examiner Initials	Cite No. <sup>1</sup>	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document mm-dd-yyyy	Pages, Columns, Lines, where relevant passages or relevant figures appear	Y <sup>2</sup>
		Office <sup>3</sup>	Number <sup>4</sup>	KindCode <sup>5</sup>				
		EP	0 006 314	A1	Wadsworth	01-09-1980		
		EP	0 121 142	B1	Whiteside	07-29-1987		
		EP	0 139 520	B1	Kenna	05-25-1988		
		EP	0 178 174	A2	Haynes	04-16-1986		
		EP	0 586 824	A1	Baltaglia	03-16-1994		
		EP	0 595 956	B1	Mikhail, et al.	09-02-1998		
		EP	0 700 272	B1	Kashuba, et al.	01-07-1999		
		EP	0 705 579	B1	Timperley	07-31-2002		
		EP	0 913 136	A3	Khalili	07-21-1999		
		WO	92/02183	A1	Mikhail, et al.	02-20-1992		
		WO	96/25113	A1	Johnson	08-22-1996		
		WO	98/29045	A1	Mikhail	07-09-1998		

Examiner Signature		Date Considered	2/18/2006
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

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**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

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Sheet 1 of 1

Application Number	10/671,820
Confirmation Number	6924
Filing Date	09/26/2003
First Named Inventor	Michael C. Jones
Group Art Unit	3733
Examiner Name	James L. Swiger, III
Attorney Docket Number	DEP5086

**U.S. PATENT DOCUMENTS**

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		Number	Kind Code <sup>2</sup> (if known)			
		5385566	A	Ullmark	01/31/1995	
		6309220	B1	Gittleman	10/30/2001	

**FOREIGN PATENT DOCUMENTS**

Examiner Initials	Cite No. <sup>1</sup>	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document mm-dd-yyyy	Pages, Columns, Lines, where relevant passages or relevant figures appear
		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup>			
		DE	3630069	C1	Aesculap-Werke	01/28/1988	
		DE	19949385	C2	Lakos	05/08/2002	
		EP	0992225	A2	Wack	04/12/2000	
		EP	0992225	A3	Wack	04/12/2000	
		EP	1208821	B1	Moore, et al	07/07/2004	
		WO	01/17444	A1	Foley, et al	03/15/2001	

Examiner  
SignatureDate  
Considered

3/18/2006

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<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

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**Notice of References Cited**

Application/Control No.

10/671,820

Applicant(s)/Patent Under

Reexamination

JONES, MICHAEL C.

Examiner

James L. Swiger

Art Unit

3733

Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2004/0087994	05-2004	Suddaby, Loubert	606/190
*	B	US-4,275,717	06-1981	Bolesky, Richard C.	606/63
*	C	US-2002/0065518	05-2002	Naybour et al.	606/86
*	D	US-3,779,239	12-1973	Fischer et al.	606/63
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	DE 3630069 C1	01-1988	Germany	PARHOFER et al.	
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
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	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*lfu*

Applicants: Michael C. Jones

Serial No.: 10/671,820

Art Unit: 3733

Filed : 09/26/2003

Examiner: James L. Swiger III

For : Radial Impaction Bone Tamp and Associated Method

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May 19, 2006

(Date of Deposit)

John S. Wagley

(Name of applicant, assignee, or Registered Representative)

/John S. Wagley/

(Signature)

May 19, 2006

(Date of Signature)

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Commissioner for Patents  
Alexandria, VA 22313-1450

SUBMISSION OF FORMAL DRAWINGS

Dear Sir:

Please find enclosed the formal drawings for the application of Michael C. Jones entitled Radial Impaction Bone Tamp and Associated Method attorney Docket No. DEP 5086, to complete this application filed on September 26, 2003 by Express Mail. As required, a copy of the Notice to File Corrected Application Paper is also attached.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Account No. 10-0750/DEP5086/JSW. This sheet is submitted in triplicate.

Respectfully submitted,

/John S. Wagley/

John S. Wagley  
Reg. No. 36,043  
Attorney for Applicant(s)

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(574) 372-7332  
May 19, 2006

